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P.
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

Barry et al.

Serial No. 10/622,201

Patent No.: 5,633,435

Issued: May 27, 1997

For: GLYPHOSATE-TOLERANT 5-
ENOLPYRUVYLSHIKIMATE-3-
PHOSPHATE SYNTHASES

Atty. Dkt. No.: 11899.0175.REUS07

**PETITION TO ACKNOWLEDGE ORIGINALLY
SUBMITTED SPECIFICATION AND CLAIMS AND
TO GRANT FILING DATE OF JULY 18, 2003**

Mail Stop Petition
Office of Petitions
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

**CERTIFICATE OF MAILING
37 C.F.R. 1.8**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Mail Stop Petition, Office of Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 7, 2004.

Matthew J. Knight
Signature

Applicants file this Petition in response to the Notice of Incomplete Reissue Application Filed under 37 C.F.R. § 1.53(b), mailed May 10, 2005 (copy enclosed).

Applicants request expedited consideration and decision of this Petition in view of the early filing of this reissue application. The processing of this reissue application has been delayed in the Office of Initial Patent Examination for 10 months. In view of the special status of reissue applications (*see* MPEP § 1442), this Petition should be addressed without further delay.

The Notice of Incomplete Reissue Application states that the specification is missing and that the specification does not include at least one claim. In response, applicants contend that the

As stated in the enclosed Petition, a copy of U.S. Patent No. 5,633,435, including the specification and claims, was filed with the original application papers on July 18, 2003. Accordingly, the Petition requests that this reissue application be granted a filing date of July 18, 2003.

Should any fees be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Deposit Account No. 01-2508/11899.0175.REUS07.

Respectfully submitted,



Janelle D. Waack
Reg. No. 36,300

Attorney for Assignee
MONSANTO TECHNOLOGY LLC

HOWREY SIMON ARNOLD & WHITE, LLP
750 Bering Drive
Houston, Texas 77057-2198
(713) 787-1400

Date: June 7, 2004

specification and claims were submitted on July 18, 2003, along with a Reissue Patent Application Transmittal, Reissue Application Fee Transmittal Form, Reissue Application Declaration by the Assignee, Offer to Surrender Patent, Preliminary Amendment, Claim for Priority under 35 U.S.C. § 120, and a postcard. The specification and claims were submitted in the form of a copy of U.S. Patent No. 5,633,435. An additional copy of that patent, which contains the specification and claims, is enclosed.

As evidence of the July 18, 2003, submission of the specification and claims, applicants enclose three exhibits:

- (1) A copy of the Reissue Patent Application Transmittal (Exhibit A), submitted July 18, 2003. This Transmittal clearly states that the application elements include a specification and claims. (*See* checkmark in box 2.)
- (2) A copy of applicants' postcard, dated July 18, 2003, which was stamped and returned by the USPTO (Exhibit B). This postcard clearly states that a specification and claims were included in the submission of July 18, 2003.
- (3) A copy of the Express Mail label EV318622128US (Exhibit C), dated July 18, 2003. This is the Express Mail label on the package containing the submission designated U.S. Patent Application Serial No. 10/622,201. The Express Mail Label number EV318622128US was also printed on the Reissue Patent Application Transmittal. The weight of that Express Mail package is listed as 1 pound, 15 ounces. The weight of U.S. Patent No. 5,633,435 is approximately 1 pound, 9 ounces. The weight of the remaining papers submitted on July 18, 2003 (Reissue Patent Application Transmittal, Reissue Application Fee Transmittal Form, Reissue Application Declaration by the Assignee, Offer to Surrender Patent, Preliminary

Amendment, Claim for Priority under 35 U.S.C. § 120, and a postcard) is approximately 4 ounces. In other words, the Express Mail package EV318622128US sent on July 18, 2003, must have contained a copy of U.S. Patent No. 5,633,435 in order to reach its weight of nearly two pounds.

Since the specification and claims were filed on July 18, 2003, this application is entitled to a filing date of July 18, 2003.

As requested in the Notice of Incomplete Reissue Application, a copy of a Statement Under 37 C.F.R. § 3.73(b) and Consent of Assignee for Reissue Application is filed with this petition. Another Reissue Application Declaration by the Assignee is also enclosed.

The petition fee of \$130.00 may be charged to deposit account number 01-2508/11899.0175.REUS07. However, since this application is entitled to its July 18, 2003, filing date, applicants respectfully request that the fee not be charged or that any charged fee be refunded.

Respectfully submitted,



Janelle D. Waack
Reg. No. 36,300

Attorney for Assignee
MONSANTO TECHNOLOGY LLC

HOWREY SIMON ARNOLD & WHITE, LLP
750 Bering Drive
Houston, Texas 77057-2198
(713) 787-1400

Date: June 7, 2004

Please type a plus sign (+) inside this box → ☐

PTO/SB/50 (4/98)
Approved for use through 9/30/00. OMB 0651-0033
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE PATENT APPLICATION TRANSMITTAL


Address to: Mail Stop Reissue Commissioner for Patents P. O. Box 1450 Alexandria VA 22313-1450	Attorney Docket No.	11899.0175.REUS07
	First Named Inventor	Gerard F. Barry
	Original Patent Number	5,633,435
	Original Patent Issue Date (Month/Day/Year)	May 27, 1997
	Express Mail Label No.	EV 318622128 US


APPLICATION FOR REISSUE OF: ☒ **Utility Patent** ☐ **Design Patent** ☐ **Plant Patent**
(check applicable box)

APPLICATION ELEMENTS	ACCOMPANYING APPLICATION PARTS
1. <input checked="" type="checkbox"/> * Fee Transmittal Form (PTO/SB/56) (Submit an original, and a duplicate for fee processing)	7. <input type="checkbox"/> Foreign Priority Claim (35 U.S.C. 119) (if applicable)
2. <input checked="" type="checkbox"/> Specification and Claims (amended, if appropriate)	8. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations
3. <input checked="" type="checkbox"/> Drawing(s) (proposed amendments, if appropriate)	9. <input type="checkbox"/> English Translation of Reissue Oath/Declaration (if applicable)
4. <input checked="" type="checkbox"/> Reissue Oath / Declaration (original or copy) (37 C.F.R. § 1.175)(PTO/SB/51 or 52)	10. <input type="checkbox"/> * Small Entity Statement(s) <input type="checkbox"/> Statement filed in prior application, Status still proper and desired (PTO/SB/09-12)
5. Original U.S. Patent <input checked="" type="checkbox"/> Offer to Surrender Original Patent (37 C.F.R. § 1.178) (PTO/SB/53 OR PTO/SB/54) or <input type="checkbox"/> Ribboned Original Patent Grant <input type="checkbox"/> Affidavit / Declaration of Loss (PTO/SB/55)	11. <input checked="" type="checkbox"/> Preliminary Amendment
6. Original U.S. Patent currently assigned? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No	12. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
	13. <input checked="" type="checkbox"/> Other: <u>Claim for Priority under 35 U.S.C. § 120</u>

NOTE FOR ITEMS 1 & 10: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.17) EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.20).

14. CORRESPONDENCE ADDRESS

<input type="checkbox"/> Customer Number or Bar Code Label		or <input checked="" type="checkbox"/> Correspondence address below			
(Insert Customer No. or Attach bar code label here)					
Name	Janelle D. Waack Howrey Simon Arnold & White, LLP				
Address	750 Bering Drive				
City	Houston	State	TX	Zip Code	77057-2198
Country	USA	Telephone	713.787.1686	Fax	713.787.1440

NAME (Print/Type)	Janelle D. Waack	Registration No. (Attorney/Agent)	36,300
Signature		Date	7/18/03

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

Please indicate receipt of the below-identified paper:

<input type="checkbox"/> New Application For: UTILITY		Priority Date:	
<input type="checkbox"/> Fgn priority claimed	Fee Amt:\$ 1074. any fee not specified	Acct No: 01-2508/11899.0175.REUS07	
<input type="checkbox"/> Continuation	<input type="checkbox"/> CIP	<input type="checkbox"/> Divisional	<input type="checkbox"/> CPA
<input checked="" type="checkbox"/> Specification:	Pages	<input checked="" type="checkbox"/> Drawings: 70 Sheets	<input type="checkbox"/> RCE
<input type="checkbox"/> Response to Office Action Dated:			
<input checked="" type="checkbox"/> Other: Reissue Patent Appln. Transmittal, Fee Transmittal Form, Specification and Claims, Drawings, Reissue Oath/Declaration. Offer to Surrender, Preliminary Amdmt, Claim for Priority and postcard.			
<input type="checkbox"/> Assignment Enclosed	<input checked="" type="checkbox"/> Cert. of Express Mailing	<input checked="" type="checkbox"/> Exp. Mail: EV 318622128 US	

IDENTIFICATION OF APPLICATION

Serial No.:	Not Yet Assigned	Filing Date:	Responsible Atty: Janelle Waack
Title:	Glyphosate-Tolerant 5-Enolpyruvylshikimate-3-Phosphate Synthases		
Applicant:	Barry et al.		
Client:	Monsanto Technology LLC	Entered By:	Mona Hernandez
To PTO VIA US Mail on	Date: 7/18/2003	Firm File No.:	11899.0175.REUS07
		Due Date:	



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PATENT

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Barry et al.

Serial No. 10/622,201

Patent No.: 5,633,435

Issued: May 27, 1997

For: GLYPHOSATE-TOLERANT 5-
ENOLPYRUVYLSHIKIMATE-3-
PHOSPHATE SYNTHASES

Atty. Dkt. No.: 11899.0175.REUS07

**RESPONSE TO NOTICE OF INCOMPLETE REISSUE
APPLICATION FILED UNDER 37 C.F.R. 1.53(b)**

Mail Stop Petition
Office of Petitions
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

**CERTIFICATE OF MAILING
37 C.F.R. 1.8**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Mail Stop Petition, Office of Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 7, 2004.

Martha J. Knight
Signature

In response to the Notice of Incomplete Reissue Application Filed under 37 C.F.R. 1.53(b), mailed May 10, 2004 (copy enclosed), applicants submit a copy of U.S. Patent No. 5,633,435, which contains the specification and claims that are the basis of U.S. Reissue Application Serial No. 10/622,201. Also enclosed are a Petition to Acknowledge Originally Submitted Specification and Claims and to Grant Filing Date of July 18, 2003, a Statement Under 37 C.F.R. § 3.73(b) and Consent of Assignee for Reissue Application, and another Reissue Application Declaration by the Assignee.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION DECLARATION BY THE ASSIGNEE

Docket Number (Optional)

11899.0175.REUS07

I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I am authorized to act on behalf of the following company: Monsanto Technology LLCand the title of my position with said company is: Intellectual Property Counsel

The entire title to the patent identified below is vested in said company.

Name of Patentee(s):

Gerard F. Barry, Ganesh M. Kishore, Stephen R. Padgette and William C. Stallings

Patent Number

U.S. Patent No. 5,633,435

Date Patent Issued

May 27, 1997

Title of Invention

Glyphosate-Tolerant 5-Enolpyruvylshikimate-3-Phosphate Synthases

I believe said patentee(s) to be the original, first and sole inventor of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled _____

Glyphosate-Tolerant 5-Enolpyruvylshikimate-3-Phosphate Synthases
the specification of which☒ is attached hereto.☒ was filed on July 18, 2003 as reissue application number 10/622,201
and was amended on _____
(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below.


☐ by reason of a defective specification or drawing.☐ by reason of the patentee claiming more or less than he had the right to claim in the patent.☒ by reason of other errors.

At least one error upon which reissue is based is described as follows:

U.S. Patent No. 5,633,435 should have included separate claims for subject matter involving SEQ ID NOs 2, 4 and 6, which have a different effective filing date than the claims for subject matter involving SEQ ID NOs 41 and 43.

All errors corrected in this reissue application up to the time of filing of this declaration arose without any deceptive intention on the part of the applicant.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(REISSUE APPLICATION DECLARATION BY THE ASSIGNEE, page 2)					Docket Number (Optional) 11899.0175.REUS07	
I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.						
Name(s)		Registration Number				
Janelle D. Waack		36,300				
Patricia A. Kammerer		29,775				
Melinda L. Patterson		33,062				
Grace L. Bonner		32,963				
<div style="display: flex; align-items: center; justify-content: space-between;"> <div style="display: flex; align-items: center;"> <input type="checkbox"/> Customer Number <div style="border: 1px solid black; width: 150px; height: 30px; margin: 0 10px;"></div> <div style="font-size: 2em; margin: 0 10px;">→</div> <div style="border: 1px solid black; padding: 10px; text-align: center; width: 150px;"> Place Customer Number Bar Code Label here </div> </div> <div style="margin-top: 10px;">Type Customer Number here</div> </div> <div style="margin-top: 10px;">OR</div>						
<input checked="" type="checkbox"/> Firm or Individual Name	Janelle D. Waack Howrey Simon Arnold & White, LLP					
Address	750 Bering Dr.					
Address						
City	Houston	State	Texas	ZIP	77057-2198	
Country	United States of America					
Telephone	1.713.787.1686	Fax	1.713.787.1440			
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.						
Full name of person signing (given name, family name) Grace L. Bonner						
Signature			Date June 3, 2004			
Residence	1527 View Woods Drive Kirkwood, MO. 63122		Citizenship USA			
Post Office Address Monsanto Technology LLC, 800 N. Lindbergh Blvd., St. Louis, MO 63167						



PATENT

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For: GLYPHOSATE-TOLERANT 5-
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PHOSPHATE SYNTHASES

Atty. Dkt. No.: 11899.0175.REUS07

**STATEMENT UNDER 37 C.F.R. § 3.73(b) AND
CONSENT OF ASSIGNEE FOR REISSUE APPLICATION**

Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

I certify that Monsanto Technology LLC is the assignee of the entire interest in the reissue application Serial No. 10/622,201, based on U.S. Patent No. 5,633,435. The assignment from the inventors to Monsanto Company was recorded September 13, 1994, at reel 7238, frame 0908. The assignment from Monsanto Company to Monsanto Technology LLC was recorded December 12, 2001, at reel 12350, frame 0232.

Monsanto Technology LLC consents to this reissue application of U.S. Patent No. 5,633,435.

I am authorized to act on behalf of assignee Monsanto Technology LLC.

Date:

June 3, 2004

Grace L. Bonner

Grace L. Bonner
Intellectual Property Counsel

MONSANTO TECHNOLOGY LLC



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
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 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/622,201	07/18/2003	Gerard F. Barry	11899.0175.REUS07

Janelle D. Waack
 Howrey Simon Arnold & White, LLP
 750 Bering Drive
 Houston, TX 77057-2198



CONFIRMATION NO. 4034

FORMALITIES LETTER



OC000000012580860

Date Mailed: 05/10/2004

NOTICE OF INCOMPLETE REISSUE APPLICATION

FILED UNDER 37 CFR 1.53(b)

A filing date has NOT been accorded to the above identified application papers for the reason(s) indicated below.

All of the items noted below **and a newly executed oath or declaration covering the items must** be submitted within **TWO MONTHS** of the date of this Notice, unless otherwise indicated, or proceedings on the application will be terminated (37 CFR 1.53(e)).

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the item(s) required below were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$130.00 petition fee (37 CFR 1.17(h)). If the petition states that the application is entitled to a filing date, a request for a refund of the petition fee may be included in the petition.

- The specification is missing.
- The specification does not include at least one claim.
A complete specification as prescribed by 35 U.S.C. 112 is required.

The required items noted below SHOULD be filed along with any items required above. The filing date of this reissue application will be the date of receipt of the items required above.

- Consent of assignee is missing. 37 CFR 1.172 requires that a reissue oath/declaration be accompanied by the written consent of all assignees.
- Assignee's statement under 37 CFR 3.73(b) establishing ownership of the patent is missing. 37 CFR 1.172 requires that all assignees consenting to the reissue application establish their ownership interest in the patent by filing in the reissue application a statement in accordance with 37 CFR 3.73(b).

Replies should be mailed to: Mail Stop Missing Parts
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

REC'D HOWREY SIMON ARNOLD & WHITE

MAY 14 2004

HOUSTON DOCKETING DEPT.

A copy of this notice MUST be returned with the reply.

Nathaniel R. Hayden

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY